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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/181,151 10/28/98 HAMILTON

A 7833

EXAMINER

WM01/0612

JAMES M STOVER
INTELLECTUAL PROPERTY SECTION
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RAMAKRISHNAIAH, M

ART UNIT

PAPER NUMBER

2643

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/181,151

Applicant(s)
Alistar R. Hamilton.

Examiner
Melur Ramakrishnaiah

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 2, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3-4, 7 and 9, are rejected under 35 U.S.C. 103(a) as being unpatentable over Dagdeviren et al. (US PAT: 5,371,534, hereinafter Dagdeviren) in view of Partridge, III (US PAT: H1714).

Regarding claims 1, Dagdeviren discloses a method of establishing audio-video conference comprising: holding an audio only conference , holding an audio conference accompanied by a live video conference (figs. 1, 4, col. 8 lines 27-68).

Regarding claim 3, Dagdeviren teaches an apparatus (fig. 1) comprising: a computer readable storage medium (215, fig. 2) , a software means, physically configured in the storage medium, receiving image data from a remote location and displaying it, holding an initial audio conference with a remote communication device, holding a sequel to the audio conference with the remote device, and holding a video conference with the remote device during the sequel (figs. 1, 4, col. 8 lines 27-68).

Dagdeviren differs from the claimed invention by not teaching displaying static visual images during the audio only conference.

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However, Partridge discloses automatic still image transmission which teaches displaying static visual images during the audio only conference (figs. 1-2, col. 3 lines 42-67, col. 4 lines 1-8).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Dagdeviren's system to provide for displaying static visual images during the audio only conference as this would enable call screening based upon calling party's image as taught by Partridge (col. 1 lines 37-43).

Regarding claims 4, 7, 9, Dagdeviren further teaches the following: initial audio conference is held using a POTS line, and sequel is held using a high-bandwidth channel, live video conference utilizes a communication channel (112,117,119), and the audio only conference utilizes a sub-channel of the communication channel, live video conference utilizes a relatively high-bandwidth communication channel (figs. 1, 4, col. 8 lines 27-68).

3. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dagdeviren in view of Morino et al. (JP409023414A, hereinafter Morino).

Regarding claim 11-13, Dagdeviren does not teach the following: during setting-up step, displaying static pictures of the conference participants on equipment latter used to hold the audio video conference, terminating display of the static pictures after setting-up complete, replacing each static picture by a live video image of the participant depicted in the static picture.

However, Morino discloses video conference system which teaches the following: during setting-up step, displaying static pictures of the conference participants on equipment latter used

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to hold the audio video conference, terminating display of the static pictures after setting-up complete, replacing each static picture by a live video image of the participant depicted in the static picture (fig. 1, see abstract).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Dagdeviren's system to provide for the following: during setting-up step, displaying static pictures of the conference participants on equipment latter used to hold the audio video conference as this would facilitate the conference participants to know other conferees that are participating in the conference, terminating display of the static pictures after setting-up complete, replacing each static picture by a live video image of the participant depicted in the static picture as this arrangement would facilitate the obtaining live and dynamic image of the conference participants as taught by Morino, thus enhancing the video conferencing capability of Dagdeviren's apparatus.

? Regarding claim 14, Dagdeviren does not teach the following: the static video images each depict a different person.

However, Partridge teaches the following: the static video images depict a different person (col. 2 lines 61-65, col. 4 lines 51-53).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Dagdeviren's system to provide for the following: the static video images each depict a different person as this arrangement would facilitate corporate presentation of slide show as taught by Partridge, thus enhancing the capability of Dagdeviren's system.

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Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 2, 5-6, 8, 10 are rejected under 35 U.S. C 102(b) as being anticipated by Dagdeviren.

Regarding claim 2, Dagdeviren teaches setting up an audio-video conference on a high bandwidth communication channel (112,117,119, figs. 1, 3, col. 7 lines 29-67, col. 8 lines 1-26), during setting up step, holding an audio conference using a POTS channel (111,116,118, fig. 1), and after setting up completes, holding audio-video conference on the high-bandwidth channel, and terminating the audio conference on the POTS channel (figs. 1, 4, col. 8 lines 27-68).

Regarding claims 5-6, 8, 10, Dagdeviren further teaches the following: parties who participate in the audio-video conference are the same parties who participate in the audio conference, audio conference is held using telephones (101,121, fig. 1), and prior to audio conference, a telephone company issued ring signals to at least some of the telephones (inherent), audio-video conference utilizes a communication channel (112,117,119, fig. 1), audio conference utilizes a sub-channel of the communication channel (fig. 3, col. 7 lines 29-68, col. 8 lines 1-26), audio-video conference utilizes a relatively high bandwidth communication channel, and audio conference utilizes a relatively low-bandwidth POTS channel (figs. 1, 4, col. 8 lines 27-68).

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Response to Arguments

Regarding Applicant's argument on rejection of claims 2, 5-6, 8 and 10, as being anticipated by Dagdeviren et al. (US PAT: 5,371,534, hereinafter Dagdeviren), Applicant argues that "Therefore, Applicants requests, under 37 CFR 99 1.104(B) and 1.106(b) and 35 U.S.C §132, that the PTO specifically identify claim 2 (b) in Dagdeviren, together with the "setting-up" step of 2(a)". However, Dagdeviren teaches the following: setting up an audio-video conference on high band width communication channels (112, 117, 118, fig. 1) to the video phone 123 (fig. 4, steps: 406-410) which is step (b) of claim 2, during the setting-up step, holding an audio conference using a POTS channel (reads on voice grade trunks 111, 116, 118, fig. 1) (fig. 4, steps 401-403). Applicant further argues that "The operations cited by the PTO as showing claim 2(b) would not be possible in, for example, 1960: ISDN lines did not exist at that time". Thus, ... because he could not operate in 1960". It is not clear from this why Applicant is invoking 1960 in his argument and further not relevant to the present case. Applicant further argues that "Dagdeviren shows a voice grade call, carried by digital signals, on ISDN channels. He specifically states that he uses "an ISDN audio ...call...carried over a digital loop". Applicant is misinterpreting Dagdeviren reference in that Applicant is ignoring the teaching of the reference which shows setting up an audio call using voice POTS channel (reads on voice grade trunks 111, 116, 118, fig. 1) (col. 8 lines 27-32, lines 49-55) and subsequently changes to high bandwidth audio video call (col. 8 lines 57-68). Since Dagdeviren clearly teaches claim limitations of independent

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claim 2, the rejection of the claim is maintained. Rejection of dependent claims 2, 5-6, 8 and 10 is also maintained as set forth in the office action dated 10-23-00.

Regarding Applicant's argument on rejection of claims 1, 3-4, 7 and 9 under 103(a) as being unpatentable over Dagdeviren in view of Partridge, III (US PAT: H1714), Applicant argues that "AS discussed in MPEP 2143.01, there must be some suggestion or motivation, either in the reference themselves ... teachings. No such suggestion or motivation has been given for combining the references". Contrary to Applicant's argument on this, motivation to combine is clearly stated in the office action dated 10-23-00 and it is as follows: Regarding claims 1, Dagdeviren discloses a method of establishing audio-video conference comprising: holding an audio only conference , holding an audio conference accompanied by a live video conference (figs. 1, 4, col. 8 lines 27-68).

Regarding claim 3, Dagdeviren teaches an apparatus (fig. 1) comprising: a computer readable storage medium (215, fig. 2) , a software means, physically configured in the storage medium, receiving image data from a remote location and displaying it, holding an initial audio conference with a remote communication device, holding a sequel to the audio conference with the remote device, and holding a video conference with the remote device during the sequel (figs. 1, 4, col. 8 lines 27-68).

Dagdeviren differs from the claimed invention by not teaching displaying static visual images during the audio only conference.

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However, Partridge discloses automatic still image transmission which teaches displaying static visual images during the audio only conference (figs. 1-2, col. 3 lines 42-67, col. 4 lines 1-8).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Dagdeviren's system to provide for displaying static visual images during the audio only conference as this would enable call screening based upon calling party's image as taught by Partridge (col. 1 lines 37-43), thus enhancing the capability of Dagdeviren's system.

Applicant further argues about the combination of Dagdeviren and Partridge and makes an argument that "However, Applicant submits that several problems exists in this rationale". Applicant says that "First Problem: both references are not needed to attain call screening". On the contrary, the primary reference Dagdeviren does not teach call screening before setting up conference whereas Partridge reference teaches call screening based on caller image displayed on the called party's video phone terminal (col. 1 lines 37-43). Therefore modifying Dagdeviren reference with Partridge gives call screening capability for Dagdeviren's system, thus enhancing the capability of Dagdeviren's system which gives the user of Dagdeviren's system call screening capability which would give the user with means of controlling the calls that user wants to receive as taught by Partridge (col. 6 lines 36-40).

With respect to rejection of claim 1, Applicant further argues that "Even if references are combined, (1) claims not obtained or (2) contrary teachings are combined" and Applicant further argues that "Partridge does not show multiple static images, in conjunction with a single

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conference. He only shows a picture of a single caller”. Contrary to Applicant’s reading of the reference, Partridge does teach displaying static visual images during audio only reference (col. 4 lines 49-53, col. 5 lines 27-32, col. 6 lines 6-15). Applicant further argues about combining Dagdeviren with Partridge and says that “Therefore, this teaching is contrary to that of Dagdeviren, who allows two parties to elect to establish a two-way video conference”. It should be pointed out that Partridge teaches displaying static images (col. 6 lines 1-15) as required by the claim limitations of claims 1 and 3 and Dagdeviren teaches holding a live video conference (fig. 4). Therefore, the combination of Dagdeviren and Partridge teaches claim limitations of independent claims 1 and 3, the rejection of claims is maintained.

Applicant’s further arguments regarding other problems in combining the references on pages 6-15 of the Applicants response are not persuasive and since combination of Dagdeviren and Partridge teaches the claim limitations of independent claims, the rejection of claims 1 and 3 is maintained. The rejection of dependent claims 4, 7, and 9 is also maintained as set forth in the office action dated 10-23-00.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (703) 305-1461. The examiner can normally be reached on Monday to Friday from 7 AM to 4 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz, can be reached on (703) 305-4708. The fax phone number for this Group is (703) 305-9508.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

8. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

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or faxed to:

(703) 308-6306, (for formal communications intended for entry)

Or:

(703) 305-9508 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).


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